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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/047,676	03/25/1998	NAOHIRO KAGEYAMA	05058/66601	3496
24367	7590	10/03/2003	EXAMINER	
SIDLEY AUSTIN BROWN & WOOD LLP 717 NORTH HARWOOD SUITE 3400 DALLAS, TX 75201			HO, TUAN V	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 10/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/047,676

Applicant(s)

KAGEYAMA ET AL.

Examiner

TUAN HO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Applicant's arguments with respect to claims 11-22 have been considered but are moot in view of the new ground(s) of rejection.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 11, 12, 14-17, and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto et al (US 6,111,604).

With regard to claim 11, Hashimoto et al discloses in Fig. 8, a digital camera that comprises the memory (memory card 15 stores image data captured by CCD image sensor 9, col. 7, line

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13), external apparatus (communication device 29, col. 8, lines 31-32), detachably attachable connection device (pin connection device of interface 27, col. 8, lines 4-22), connector (connector RS-232, col. 4, lines 48-61, Figs. 2A and 2B), detector for detecting (step 304 of Fig. 14, col. 10, lines 51), and controller for transitioning the camera (CPU 23, col. 8, lines 1-37, col. 10, lines 17-67, and col. 11, lines 1-19).

With regard to claim 12, Hashimoto et al discloses in Fig. 8, a digital camera that comprises the personal computer (communication device 29 is a personal computer, col. 8, line 32).

With regard to claim 14, Hashimoto et al discloses in Fig. 8, a digital camera that comprises the storage apparatus (the digital camera is able to exchange files to a personal computer ; in other words, the computer is inherently a storage device, col. 8, lines 31-36).

With regard to claim 15, Hashimoto et al discloses in Fig. 8, a digital camera that comprises the connection cable (col. 4, line 48-61, and col. 8, line 7).

With regard to claim 16, claim 16 recite what was discussed with respect to claim 11.

With regard to claim 17, claim 17 recites what was discussed with respect to claim 15.

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With regard to claim 19, Hashimoto et al discloses in Fig. 8, a digital camera that comprises the storage device (a personal computer, col. 8, lines 31-36 and col. 2, lines 11-35 and col. Col. 10, lines 41-67).

With regard to claim 20, Hashimoto et al discloses in Fig. 8, a digital camera that comprises the personal computer (col. 8, lines 32).

With regard to claim 21, Hashimoto et al discloses in Fig. 8, a digital camera that comprises the detector (Hashimoto discloses in col. 10, lines 41-67, that the detector circuit of the digital camera places the camera in a communication mode and transmit data via pin connections; therefore, if there is no connection detected, CPU 23 does not place the camera in the communication mode; in other words, the Cpu inhibits the outputting data via the connections).

With regard to claim 22, Hashimoto et al discloses in Fig. 8, a digital camera that comprises the memory card (memory card 16).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter

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sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al in view of Suzuki'605.

With regard to claim 18, Hashimoto et al discloses the same subject matter as discussed with respect to claim 16, except for the external apparatus is a printer.

Hashimoto et al does not explicitly disclose any printer; However, Suzuki teaches using printer 301 (Fig. 1, col. 10, line 30) so as to print image data on a hard copy and thereby easily archive the data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace communication device 29 of Hashimoto et al with the printer of Suzuki because the replacement of the printer in the Hashimoto camera system would allow a user to make a image presentation by using a hard copy and easily to archive the image data.

Claim 13 recites what was discussed with respect to claim 18.

4. This Office action is not made Final since new grounds of rejection applied to the claims.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan Ho whose telephone number is (703) 305-4943. The examiner can normally be reached on Monday-Friday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber, can be reached on (703) 305-4929.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**


**(703) 872-9314**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

th

9/30/03

  
TUAN HO  
PRIMARY EXAMINER